

REMARKS

By the foregoing amendments, claim 2 has been incorporated into the independent claims, and conforming changes in other claims required as a result of that incorporation have been made. In addition, the bacteria identified by the Examiner as not being enabled have been deleted from the claims, and the bacteria which the Examiner indicated was enabled only for being fucidic acid resistant has been identified as such.

The provisional obviousness-type double patenting rejection is respectfully traversed. A double patenting rejection requires the use of the claims of an issued patent as a "reference" and the other application has not issued. There is, therefore, no "reference" on which this rejection can be based. It is also noted that when two copending applications are rejected on this ground, the first to be in condition to be allowed is in fact allowed and the double patenting issue is handled in the other case. This case should be the first which is in condition to be allowed.

The rejection of claims prior 1, 2, 4, 8-14, and 18-27 under 35 U.S.C. § 112, first paragraph, on the grounds of enablement is respectfully submitted to be moot in light of the elimination of those bacteria identified in the Final Rejection as not being enabled.

The rejection of claims 1, 2, 8-10, 18, 22, and 27, under 35 U.S.C. § 103 over Swanbeck is respectfully traversed.

Swanbeck teaches a topical treatment of bacteria and can comprise the application of pentane-1,5-diol. However, the "bacteria" which are referenced in Swanbeck are not resistant strains and activity against such a bacteria does not provide

any reasonable basis for believing it will be effective against a strain of the same bacteria which has become multiple-resistant, particularly since the very definition of multiple-resistant is a loss of antibiotic activity. Quite to the contrary, the fact that bacteria has developed a resistance to agents use to combat it suggests looking elsewhere for a solution to resistance problem. In response to the observation at the top of page 17 of the Final Rejection, while the clindamycin example may suggest it is possible to find some active agent, it does not suggest that agent is 1,5-pentane diol. Indeed, the Final Rejection itself in the course of the enablement rejection, advanced the position that the activity of this diol against multiple resistant bacteria was not predictable, and that the amount of experimentation necessary to determine if 1,5-pentane diol was active was undue, i.e., there was no reasonable expectation of success. For these reasons, it is respectfully submitted that the rejection is untenable.

The rejection of claims 1, 8, 10-13, 20, 22, 23, and 24 under 35 U.S.C. § 103 over Goodman in view of Tsao is moot in light of the inclusion of claim 2 into the independent claim. For the same reason, the rejection of claims 13 and 25 under 35 U.S.C. § 103 over Goodman in view of Tsao and Noll is likewise moot.

The rejection of claims 4, 14, 19, 21, and 26 under 35 U.S.C. § 103 over Swanbeck in view of Buseman is respectfully traversed. Swanbeck has been discussed above and shown not to render the independent claim on which these claims are dependent obvious. The Buseman reference has been cited solely to teach adhesive patches and is therefore not advanced in order to cure any of the deficiencies in Swanbeck. As a result, those deficiencies remain. Accordingly, these claims are unobvious over the combination.

Acknowledgment of the IDS filed after issuance of the Final Rejection is respectfully requested.

In view of the above amendment and remarks, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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